



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 15719US00)

PATENT APPLICATION OF:)
)
Donovan)
)
SERIAL NO.: 09/385,802)
)
FILED: August 30, 1999)
)
FOR: Universal Instant Messaging System)
for the Internet)
)
Art Unit: 2153)
)
Examiner: Flynn, Kimberly D.)
)
Confirmation No.: 9671)

DECLARATION UNDER 37 C.F.R § 1.131

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PKT Technologies, LLC, the assignee of the present application, declares the following :

1. Representatives of assignee, PKT Technologies, LLC, have attempted to contact Kevin Donovan, the sole inventor of the present application, by telephone and email regarding this application.
2. After assignee's representatives made initial contact with Mr. Donovan, he refused to respond to further inquiries made by a variety of means.
3. These attempts to secure the cooperation of Mr. Donovan have extended over several months.

4. Thus, it is not possible to produce an affidavit or declaration of Mr. Donovan, as he appears to be uncooperative.

5. Upon information and belief, Kevin Donovan was employed by Prodigy Communications Corporation and developed a system and method for allowing instant messaging between different service providers.

6. Upon information and belief, prior to the filing date of United States Patent No. 6,549,937 (“Auerbach”), which is July 21, 1999, Mr. Donovan, the inventor of the present application, reduced to practice the invention as defined by claims 16-20, and 22 of the present application, as evidenced by the email attached as Exhibit A, and by the press release attached as Exhibit B.

7. The email (Exhibit A) states, in part, that “Kevin [Donovan] expects to deliver to us an AIM [AOL Instant Messaging] compatible build either this Thursday or Friday.” *See* Exhibit A.

8. The email also states “PI [Prodigy Internet] members will be able to IM [instant message] anyone who uses AOL’s AIM client (and vice versa), regardless of what service they’re on. In addition, PI members will be able to tell when they’re AIM-enabled friends are online (and vice versa).” *See id.*

9. The dates listed on the email have been redacted, but those dates antedate the filing date of Auerbach.

10. The press release (Exhibit B), which is dated May 5, 1999, states, in part, the following:

Today, Prodigy Communications Corporation... will debut its Beta version of Prodigy Instant Messaging™ Version 2.0 (PIMTM V2). Prodigy’s next generation instant messaging (“IM” product is

the only one on the market that is compatible with multiple IM platforms such as IRC and AOL InstantMessengerSM (AIMSM), allowing Prodigy ChatTM users to talk to AOL members using AIM.

* * *

The PIM V2 list of new features includes:

Multiple Platform Agility: PIM V2 is a first-of-its kind product that allows Prodigy subscribers to send and receive instant messages with users of multiple chat platforms (such as AOL's AIM, Prodigy Chat, or IRC) simultaneously

* * *

Friends online: PIM V2 features the "Prodigy Friends" tool, which allows users to create lists of online friends from Prodigy Chat and AIM that will pop up an [sic] alert whenever a friend from either service comes online. Users can talk instantly, either individually, or among groups of friends to users on AIM and Prodigy Chat simultaneously.

See Exhibit B.

11. I certify that all statements made herein of my own knowledge are true, and that all statements made herein on information and belief are believed to be true. I understand that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.

PKT Technologies, LLC

By: 

Name: PETER K TRZYNA

Title: MANAGER

Date: 11 November 2004

Subject: Re: IM w/ AIM

Date: [REDACTED]

From: PETER NEMARICH <peter@prodigy.net>

Organization: Prodigy Internet

To: albert@prodigy.net

CC: krjbd@prodigy.net

Exhibit A
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albert@prodigy.net wrote:

>

> *Please touch base with Kevin to get an understanding of what the AIM (Aol
> Instant Messenger) support means and then assess what it means to the
> testing effort.*

Kevin expects to deliver to us an AIM-compatible build either this Thursday or Friday. We don't need an AOL account to test this; just the AIM client. As a sheer guess, I imagine that we would want to test the AIM-capable portion of the client for about a half day, probably using two people, each using two side-by-side machines. (Technically, I suppose you could also run both clients simultaneously on one machine, but I'd rather use two separate machines to better simulate the real world.)

Since this product is a standalone, I think the main thing we need to test against is a variety of OS, but not necessarily browsers or kits. However, it couldn't hurt for us to continue testing on machines set up with the OS/kit/browser combos that we've been using (see daily note) -- just in case there are any odd interactions or memory shortages.

The scheduled release on [REDACTED] will be called a beta.

ABOUT THE AIM-COMPATIBLE CNG PRODUCT:

PI members will be able to IM anyone who uses AOL's AIM client (and vice versa), regardless of what service they're on. In addition, PI members will be able to tell when they're AIM-enabled friends are online (and vice versa).

In the AIM-compatible version, the app will enable the user to create an AIM Persona. The Friends List will have a separate "AIM Friends" group. The AIM user will see the PI member as just another nickname; there will be no indication that the user is on PI.

While the new AIM-compatible build will support IM with AIM-enabled users outside of PI, it will not support File Transfer or regular Chat.

Incidentally, the product will not be called CNG. A name being considered is Prodigy Intercom (possibly spelled as "Inter.Com"), but that is not yet definite. Another name being considered is "Prodigy Inter.Net" [REDACTED]
[REDACTED]



PRODIGY CENTRAL NAVIGATOR

PRESS RELEASE

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Title: Prodigy Unveils Next Generation of Instant Messaging
Category: Tools

Effective Date Of Release: 05/05/99 Resume Trading on

Prodigy Unveils Next Generation of Instant Messaging *PIMTM V2 to be Released this Fall in English and Spanish*

WHITE PLAINS, NEW YORK (May 5, 1999) - Today, Prodigy Communications Corporation (NASDAQ NMS: PRGY) will debut its Beta version of Prodigy Instant Messaging™ Version 2.0 (PIMTM V2). Prodigy's next generation instant messaging ("IM") product is the only one on the market that is compatible with multiple IM platforms such as IRC and AOL Instant Messenger™ (AIMSM), allowing Prodigy Chat™ users to talk to AOL members using AIM. In addition, the new PIM V2 also offers real-time file and audio transfer capabilities, advanced chat room features, and more software upgrades to the messaging features most commonly used by consumers.

"PIM V2 is basically instant messaging on steroids-incredible usability, unparalleled file-transfer features and the bridging of networks that'll break down the barriers to on-line communication between different platforms," said Prodigy Chief Technology Officer Bill Kirkner. "Prodigy pioneered chat technology, which is now one of the most popular uses of Internet access-only with this new version, we gave it some major interactive muscle."

The PIM V2 list of new features includes:

Multiple Platform Agility: PIM V2 is a first-of-its-kind product that allows Prodigy subscribers to send and receive instant messages with users of multiple chat platforms (such as AOL's AIM, Prodigy Chat, or IRC) simultaneously.

Sound & File Transfers: Using PIM V2, Prodigy users could, for example, send a recorded sound file (singing a birthday song) to a virtual surprise birthday in a special chat room with the whole family attending on-line. Or using PIM V2, users can send photos or files within a chat session without having to exit to an external program, such as mail. Additionally, Prodigy has preprogrammed a list of customized sounds and fun messages in both Spanish and English to give PIM V2 users a more exciting and interactive online experience. Users can also easily add their own recorded sounds and customized messages.

Friends online: PIM V2 features the "Prodigy Friends" tool, which allows users to create lists of online friends from Prodigy Chat and AIM that will pop up an alert whenever a friend from either service comes online. Users can talk instantly, either individually, or among groups of friends to users on AIM and Prodigy Chat simultaneously.

Chat Mansions (Many, many chat rooms): Prodigy Chat features over 600 public chat

rooms that are capable of handling hundreds of Prodigy members at a time. Customers can also set up smaller private chat rooms for family and friends, and members can participate in multiple rooms (both private and public) simultaneously. Prodigy Chat also includes the ability to establish three different "handles" (or nicknames) which can be tied to each other, allowing users to receive messages sent to one nickname while logged in under a different nickname.

All technology trade media are encouraged to view the Prodigy Instant Messaging Web site at pim.prodigy.net. Additionally, Prodigy is soliciting feedback on the product from a sample group of Prodigy subscribers via an online feedback center. Consumer comments and suggestions will be considered in final product development. A final version of Prodigy Instant Messaging Version 2.0 is scheduled to be released later this year and will be available in both English and Spanish. PIM V2 is available for 32-bit Windows® platforms and is in development for Macintosh® OS 8.x.

About Prodigy Communications Corporation:

Prodigy Communications Corporation is a leading nationwide Internet service that provides fast and reliable Internet access and related value-added services. Prodigy utilizes a nationwide network covering more than 750 cities in all 50 states allowing approximately 83% of the United States population to access Prodigy's services with a local telephone call. Prodigy Internet enables the Internet to be used as a productivity tool by allowing subscribers to obtain and communicate desired information quickly and efficiently in an easy and personalized manner.

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This press release contains forward-looking statements that involve a number of risks and uncertainties. Among the important factors that could cause actual results to differ materially from those indicated by such forward-looking statements are the intense competition in the Company's industry, subscriber turnover, disruption in the Company's network services or in other services provided by third parties, the impact of year 2000 issues, as well as the risk factors detailed from time to time in the Company's periodic reports and registration statements filed with the Securities and Exchange Commission.

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